

REMARKS

In the present application, claims 1-30 are pending. Claims 1, 15, 28 and 29 are independent claims from which claims 2-14, 16-27 and 30 respectively depend. Claims 1, 3-5, 8-10, 14-15, 27 and 29-30 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Jellum et al. Claim 28 has been rejected under 35 U.S.C. § 102(a) as being anticipated by Kikinis et al. Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jellum et al. in view of Levy et al. Claims 6-7 and 24-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jellum et al. in view of Bates et al. Claims 11-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jellum et al. in view of Chanos et al. Claims 16-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jellum et al. in view of Yu.

A declaration under 37 CFR § 1.131 executed by Attila Narin is enclosed. The declaration is made by only Mr. Narin because he was the joint inventor primarily responsible for reducing the first working prototypes of the invention to practice as indicated in his declaration. A declaration under 37 CFR § 1.131 executed by Jeffrey R. Hemmen is enclosed corroborating Mr. Narin's declaration.

I. Rejections under 35 U.S.C. §§ 102 and 103 over the Jellum Patent

Claims 1, 3-5, 8-10, 14-15, 27 and 29-30 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by the Jellum patent. Also, claims 2, 6-7, 11-13, 16-26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable for obviousness in view of the Jellum patent combined with various prior art references. As described in the attached declaration pursuant to 37 CFR 1.131 Jellum has an earliest priority date of March 28, 2001. Prior to March 28, 2001, the inventors constructed and tested an initial feasibility model of the invention and participated in an engineering review meeting of a document representing the final stage of the product definition effort. The inventors completed the invention disclosed in the above-identified patent application and claimed in claims 1-27 and 29-30 prior to March 28, 2001. Accordingly, Jellum is antedated by the Applicants' invention, and therefore claims 1, 3-5, 8-10, 14-15, 27 and 29-30 should not be rejected as anticipated by Jellum under 35 U.S.C. § 102(e); claim 2 should not be rejected under 35 U.S.C. § 103(a) as

being unpatentable over Jellum et al. in view of Levy et al.; claims 6-7 and 24-26 should not be rejected under 35 U.S.C. § 103(a) as being unpatentable over Jellum et al. in view of Bates et al.; claims 11-13 should not be rejected under 35 U.S.C. § 103(a) as being unpatentable over Jellum et al. in view of Chanos et al.; and claims 16-23 should not be rejected under 35 U.S.C. § 103(a) as being unpatentable over Jellum et al. in view of Yu. (See MPEP 715.02: “Applicant may overcome a 35 U.S.C. § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references...”. Withdrawal of the rejection of claims 1, 3-5, 8-10, 14-15, 27 and 29-30 under 35 U.S.C. § 102(e) and of claims 2, 6-7, 11-13, and 16-26 under 35 U.S.C. § 103(a) is respectfully requested. Because the Rule 131 Declaration of Attila Narin provided herewith demonstrates that Applicants’ invention was conceived and reduced to practice prior to the earliest effective filing date of the Jellum patent, that patent is not “an application for patent ... filed in the United States before the invention by the applicant for patent,” and thus does not constitute prior art under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request that the 35 U.S.C. § 102 and 103 rejections based on the Jellum patent be withdrawn.

II. Rejections under 35 U.S.C. § 102(a) over the Kikinis Patent

Claim 28 has been rejected under 35 U.S.C. § 102(a) as being anticipated by Kikinis et al. Claim 28 recites:

A method for distributing a variation of software through one of a plurality of entities, comprising:
 providing a standardized version of software; and
 providing a customized version of said software *as a function of one of a plurality of entities.*

(emphasis added). Kikinis et al. describes a miniature personal digital assistant (PDA) having features designed to address problems associated with early PDAs including size (bulk), problems with data transfer and synchronization between host and PDAs and other problems. Kikinis also describes a vending machine that dispenses software to a PDA in one of several modes. Which version of software dispensed to the PDA may be based on a unique feature of the PDA, such as serial number or other code. Hence, Kikini’s (single)

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vending machine dispenses a plurality of versions of software (depending on the serial number of the PDA), while in contrast, Applicants' claim recites "providing a customized version of said software as a function of one of a *plurality of entities*". That is, the customized version of software provided depends on which entity *provides* the customized version of the software, instead of on the device that *receives* the customized software. As Kikini does not disclose or suggest at least this features of Applicants' claim 28, Applicants respectfully request the withdrawal of the 102 rejection of claim 28.

In view of the above amendments and remarks, Applicants respectfully submit that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. If the Examiner believes a telephone conference would be useful in moving the case forward, the Examiner is encouraged to contact the undersigned at (215) 557-5933.

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